

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the following commentary.

I. Claims Status

Claim 1 has been amended to delete reference to SEQ ID NO: 3 and to the phrase “substantially purified.” The claimed oligonucleotides may or may not be substantially purified.

Claim 8 has been added, with support found in the original claim 1. Claim 7, which was deemed withdrawn by the examiner as being directed to an unelected invention, has been cancelled without prejudice or disclaimer. Upon entry of the amendment, claims 1-6 and 8 will be pending.

II. Statement of the Substance of the Interview

A telephonic interview was conducted on August 15, 2006, between Examiner Bao Qun Li and Applicants’ representative, Barry Wilson. The Examiner offered to narrow the claims for an allowance. No agreement as to claim amendments was reached.

III. Claim Rejection under 35 U.S.C. 102(b)

The Examiner rejected claims 1 and 2 for alleged anticipation by U.S. Patent No. 5,681,691 (*sic* 5,681,697) to Urdea *et al.*, U.S. Patent No. 5,635,352 to Urdea *et al.*, Gene bank accession No. AF 059603, and Japanese Application Publication No. 103899 (*sic* 11-103899) to Michinori *et al.*, respectively. Applicants respectfully traverse each of the rejections.

Before addressing the substance of the rejection, Applicants wish to correct the record with respect to the identity of the alleged prior art. The Examiner cited to U.S. Patent No. 5,681,691 (Bose *et al.*), however, Applicants assume that U.S. Patent No. 5,681,697 to Urdea *et al.* was intended. The Examiner cited to Japanese Application Publication No. 103899, which Applicants assume is Japanese Application Publication No. 11-103899.

Urdea et al. Patents

Specifically, the Examiner alleges that the cited patents to Urdea disclose SEQ ID NO: 15 which comprises “the claimed polynucleotide with 100% identity” with sequences in claims 1 and 2. The Examiner does not provide Applicants with an alignment or otherwise identify the segment of the sequence in the reference which allegedly is identical to any of the sequences recited in the claims.

Applicants have examined SEQ ID NO: 15 of the Urdea patents but have found nothing in that sequence which is 100 % identical to any of the recited sequences in claims 1 and 2. Because the cited patents to Urdea do not disclose each and every element of the claimed invention, Applicants respectfully request withdrawal of the anticipation rejection of claims 1 and 2. Should the Examiner maintain the rejection, Applicants request that the Examiner provide an alignment or otherwise indicate precisely where the recited sequence of the claim is found in the reference.

Gene bank accession No. AF 059603

The Examiner alleges that Gene bank accession No. AF 059603 anticipates claim 1 because the reference comprises “the claimed polynucleotide with 100% homology.” The Examiner does not provide Applicants with an alignment or otherwise identify the sequence in the reference which allegedly is identical. Gene bank accession No. AF 059603 is a partial coding sequence of wheat rosette stunt virus nucleocapsid protein (N) mRNA with a size of 1337 bp.

Applicants have examined Gene bank accession No. AF 059603 but have found no sequence that is identical to any of SEQ ID NOs 4-6 recited in claim 1. Thus, Gene bank accession No. AF 059603 does not anticipate the claimed invention and withdrawal of the rejection is respectfully requested. Should the Examiner maintain the rejection, Applicants

request that the Examiner provide an alignment showing precisely where the recited sequence of the claim is found in the reference.

Japanese Application Publication No. 11-10389 (Michinori *et al.*)

The Examiner further alleges that residues 10-33 of Michinori's SEQ ID NO: 1 are 100% identical to SEQ ID NO: 3 recited in claim 1. Without acquiescing to the stated basis for the rejection, Applicants have rendered this issue moot by deleting reference to SEQ ID NO: 3 from claim 1. It is noted that newly added claim 8, which recites an oligonucleotide having a sequence "consisting of" SEQ ID NO: 3, is not anticipated by Michinori's SEQ ID NO: 1, which is a much larger molecule.

IV. Claim Rejection under 35 U.S.C. 103(a)

The Examiner rejected claims 1-6 for obviousness over Michinori *et al.*, Kawai *et al.* and Lee *et al.* Applicants respectfully traverse the rejection. Applicants note that this rejection appears to be directed primarily if not exclusively to SEQ ID No. 3 in claim 1 because the Examiner states at page 4 of the Action that "primers of SEQ ID NO:4 and SEQ ID NO: 5 are free of art rejection; however they are not allowable because they depend on the rejected claims." The rejection appears therefore to be rendered moot since SEQ ID NO:3 has been deleted from claim 1. Nevertheless, Applicants traverse this rejection as follows.

Pursuant to MPEP 2142, "to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Michinori does not teach or suggest an oligonucleotide having a sequence of any of the claimed SEQ ID NOs 4-6. Kawai and/or Lee do not remedy this deficiency. Thus, the cited art

fails to teach or suggest all of the elements of the claims. Moreover, the Examiner did not provide any suggestion or motivation in any of the cited secondary references to combine the teachings to arrive at the claimed oligonucleotides. Thus, the Examiner failed to establish a *prima facie* obviousness rejection. Accordingly, Applicants respectfully request withdrawal of the obviousness rejection of claims 1-6.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

Date

01/09/2007

By

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